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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,172	10/20/2003	Duane A. Lunsford	58683US003	2716

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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/689,172

Applicant(s)

LUNSFORD ET AL.

Examiner

Daniel Zirker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 29-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Newly submitted claim 38 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: More particularly, the newly presented claim contains two different issues of patentability from the pending independent claims and is also similar in certain respects to nonelected and cancelled claim 12 which also had no limitations (i.e. the non permittal of adhesives having a certain acrylic acid content) related to the adhesive layer. Additionally, it also "consists essentially of" surface modified nanoparticles, a limitation not found in either the pending independent article or method claim. Furthermore, if this claim were to be examined it would clearly expand the field of search and constitute additional issues of patentability for the Examiner.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 38 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Claims 1-11 and 29-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lange et al., taken either individually, or for claims 6 and 32 in view of Melancon et al, or for all the claims in view of EP '756, the latter two references taken as evidence of the state of the art, substantially for the reasons set forth in Paragraph No. 12 of Paper No. 051605, together with the following additional observations.
Applicants argument (Response, page 8, top paragraph) that in view of their arguments

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and submitted Declaration of Robert Murray that they have distinguished the prior art by their claim amendments which now exclude embodiments having an adhesive layer which comprises no more than about 3% by weight acrylic acid repeat units would be an effective argument against an anticipation rejection, but, it is respectfully submitted, is clearly inadequate against an obviousness rejection. Note that Lange et al at Col 4, lines 5-9 clearly teaches that the reference primer is clearly suitable "as a primer for adhering adhesives to substrates", with no restrictions whatsoever on the type of adhesive used. Additionally, except for the pointed out reference to the Scotch Brand Tape at Col 6, lines 31-34 (Example 1) there appears to be no other recitation of the use of any acrylic adhesive and note that nowhere, including this Example, does the reference either discuss or even mention the acrylic acid (or any other acrylic related) content of the adhesive; note also that just because the acrylic acid content in the commercial embodiment testified to by Mr. Murray is a certain value it does not restrict the teachings of a reference which should happen to mention this trademark identified embodiment from inferring that other values might also be taught or are suitable. Finally, with respect to EP'756, to hold that this reference, relied upon as evidence of the state of the art which teaches that a multitude of adhesives are suitable for use with a very similar primer is not relevant for its teaching that many different classes of adhesives can be used in conjunction with the similar type primers to that which applicants use only because it also utilizes an ambifunctional silane in the primer is simply an unsupported allegation lacking any sort of supporting evidence on the record.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Zirker
Primary Examiner
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A handwritten signature in black ink that reads "Daniel Zirker". The signature is written in a cursive style with a large, stylized 'D' and 'Z'.